

PATENT**Application # 09/642,980****Attorney Docket # 1999-0587 (1014-091)****REMARKS**

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Claim 42 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification thereby not narrowing the scope of the claim, to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of a claim of particular current licensing interest, to target the claim to a party currently interested in licensing certain embodiments, to enlarge the royalty base of the claim, to cover a particular product or person in the marketplace, and/or to target the claim to a particular industry.

Each of claims 1-41, 43, and 44 has been cancelled without prejudice or disclaimer. Claims 45 - 68 have been added. Claims 42 and 45-68 are now pending in this application. Claims 42, 45, and 68 are the independent claims.

I. The Obviousness Rejection

Claim 42 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas (U.S. Patent No. 6,421,339) in view of Christie (US Patent No. 6,657,992 B1). This rejection is respectfully traversed.

To the extent that official notice is taken to support the rejection, Applicants respectfully traverse and request citation and provision of a reference that supports the rejection. See MPEP 2144.03. Specifically, Applicant respectfully requests provision of a reference that supports the statement "the placement of the database relative to domains is completely a matter of design choice. The important aspect of the system is that there is a database used to store and translate

PATENT

Application # 09/642,980

Attorney Docket # 1999-0587 (1014-091)

addresses for routing of communication. Where these databases are placed does not change the overall function of the system." See Advisory Action dated 25 January 2005.

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP § 2143.

Thomas Teaches Away From Combination With Christie

Independent claim 42 recites "receiving, at a wide area network-based intelligent service controller, a request to originate a call to an H.323 entity, the request comprising an alias address associated with the H.323 entity, the wide area network-based intelligent service controller comprising a non-gatekeeper database external to a domain of a calling entity and external to a donor domain of the H.323 entity."

As recognized in the Office Action dated 14 September 2004 (hereinafter the Office Action), Thomas does not expressly or inherently teach or suggest "receiving, at a wide area network-based intelligent service controller, a request to originate a call to an H.323 entity, the request comprising an alias address associated with the H.323 entity, the wide area network-based intelligent service controller comprising a non-gatekeeper database external to a domain of a calling entity and external to a donor domain of the H.323 entity."

To remedy the deficiencies of Thomas, the Office Action cites Christie for a database external to a domain of the gatekeeper and external to a domain of the H.323 entity.

PATENT

Application # 09/642,980

Attorney Docket # 1999-0587 (1014-091)

Yet, Thomas allegedly states that “[a]s will be apparent, the home network **must be** contacted first **and then** contact be made with the visited network for instructions on where to direct packets to the visited network”. See col. 6, lines 16-20. Thus, Thomas allegedly teaches that “instructions on where to direct packets” are received from “the visited network”.

If one equates Thomas’ “instructions on where to direct packets” to the claimed “called routable alias address”, and Thomas’ “home network” to the claimed “donor domain of the H.323 entity,” then Thomas requires that the “called routable alias address” is received from a “donor domain of the H.323 entity” rather than from “external to ... a donor domain of the H.323 entity”. Consequently, Thomas teaches away from “receiving, at a wide area network-based intelligent service controller, a request to originate a call to an H.323 entity, the request comprising an alias address associated with the H.323 entity, the wide area network-based intelligent service controller comprising a non-gatekeeper database external to a domain of a calling entity and external to a donor domain of the H.323 entity.”

Because “[i]t is improper to combine references where the references teach away from their combination” (see *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); MPEP 2145), it is improper to combine Christie with Thomas.

Consequently, Christie is unavailable to combine with Thomas. Without Christie, Thomas does not expressly or inherently teach or suggest every limitation of the independent claims.

Christie Does Not Teach or Suggest Inter-domain Communication

Independent claim 42 recites “a non-gatekeeper database external to a domain of a calling entity and external to a donor domain of the H.323 entity.”

As explained in the present application, “[t]he present invention provides an overall architecture and overview of the protocol for the user, service, and service provider **mobility** in

PATENT

Application # 09/642,980

Attorney Docket # 1999-0587 (1014-091)

the context of inter-domain communications although the same principles can also be used for intra-domain or inter-zone communications.” See page 23, lines 1-3.

To provide such “user, service, and service provider mobility,” the present application assumes (for simplicity) that “[e]very administrative domain has a single zone.” See page 12, lines 3-5. Thus, a “zone” is a constituent of a “domain.” Those of skill in the art agree with the International Telecommunications Union that a “domain” is a “set of host names consisting of a single domain name and all the domain names below it” and that a “zone” is a “contiguous portion of a domain”. See <http://www.itu.int/osg/spu/enum/workshopjan01/annex6-glossary.html/>.

The Network Working Group provides support for this definition by stating a “the domain system consists of separate sets of local information called zones.” See P. Mockapetris, Network Working Group, Request for Comments: 1034, ISI, November 1987 available at <http://www.faqs.org/rfcs/rfc1034.html> (last visited 9 February 2005). Note that the Network Working Group is a group created by ARPA. ARPA is responsible for establishing protocols and standards for IP networks such as the Internet. See, e.g., The Network Working Group, History of ARPANET, available at <http://www.deli.isep.ipp.pt/docs/arpa-2.html> (last visited 10 February 2005).

Christie allegedly recites a “first zone 101 is comprised of a plurality of terminals or clients 102 connected to a computer network 104 such as, for instance a local area network (LAN or a wide area network (WAN) which is serviced by a first zone manager 106 ... a second zone 107 is also comprised of a plurality of terminals or clients ... which is serviced by a second zone manager.” See col. 2, lines 31-42. Christie makes no mention of communication between domains. Thus, Christie does not contemplate expressly or inherently teach or suggest communication or alias portability between domains whatsoever.

Thus, Christie does not explicitly or implicitly teach or suggest “a non-gatekeeper database external to a domain of a calling entity and external to a donor domain of the H.323 entity.”

PATENT

Application # 09/642,980

Attorney Docket # 1999-0587 (1014-091)

Consequently, even if there were motivation or suggestion to modify or combine the cited references (an assumption with which the applicant disagrees), and even if there were a reasonable expectation of success in combining or modify the cited references (another assumption with which the applicant disagrees), the cited references still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Summary

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

II. Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

"none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely,

claims 42 is allowable because none of the references of record alone or in combination disclose or suggest 'receiving, at a wide area network-based intelligent service controller, a request to originate a call to an H.323 entity, the request comprising an alias address associated with the H.323 entity, the wide area network-based intelligent service controller comprising a non-gatekeeper database external to a domain of a calling entity and external to a donor domain of the H.323 entity'; and

claims 45-68 are allowable because none of the references of record alone or in combination disclose or suggest 'receiving, a called routable alias address for the called H.323 entity, the called routable alias address

PATENT**Application # 09/642,980****Attorney Docket # 1999-0587 (1014-091)**

associated with the alias address of the called H.323, the called routable alias address received from a non-gatekeeper database external to the first domain, the second domain, and the third domain. ""

CONCLUSION


It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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